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10/032,684	10/22/2001	Thomas R. Wulff	83573RLO	7300

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EXAMINER

ZURITA, JAMES H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,684

Applicant(s)

WULFF ET AL.

Examiner

James H Zurita

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

The drawings are objected to because of the following informalities:

Fig. 1, item 127 is called a package.

Item 1130 is described as a consumer personal picture, and appears to correspond to item 1110.

Items 1140 and 1150 are not shown in Fig. 11.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

Page 8, line 1, refers to Fig. 1a. this appears to be an error and should refer to Fig. 1b.

Page 10, lines 22-29 refer to consumer authorization code 50. Consumer authorization code is item 250 in Fig. 2.

Page 10, line 22 refers to demographic data 250. Demographic data is item **240** in Fig. 2.

Page 11, line 4 reads "...which receives 310 and stores 20 such consumer ..." and should be corrected to "...which receives 310 and stores **320** such consumer..." to match Fig. 3.

Page 11, line 14, reads "...The sponsor selects 430..." and should be corrected to "...The sponsor selects **420**..." to match Fig. 4.

Page 14, line 19 refers to "...consumer personal picture 1130..." This appears to be an error. Fig. 12 shows what appears to be a consumer personal picture as item 1110.

Appropriate correction is required.

Claim Objections

The claims are objected to for various informalities:

In claims 1, 5, 7 and 8, applicant refers to various combinations of the words {audio, digital, files, image, video}. It is not clear whether applicant claims a patentable distinction by the use or absence of the words. For example:

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- Digital audio file (claim 7).
- Digital image file, Claim 1, preamble, "...from digital image files...".
- Digital image, claim 1(a), 1(b), 1(d), claim 5.
- Digital video [file?] (claim 8)
- Image, claim 1 preamble "...delivering [digital?] images...", 1(a), 1(b) and 1(e) "...such image(s)...", 1(c) "...corresponding image..."
- Merged digital [image?] file, claim 1(d), 1(e), 1(g).
- Merged [digital?] image, claim 1(f), twice, as printing a merged image

In Claim 1(b), the highlighted **to** appears to be extraneous:

"...a sponsor electronically transmitting at least one sponsor digital image and demographic requirements identifying consumers and recipients and specifying at least some of the sponsor digital images which based upon correlation between the demographic information and the demographic requirements **to** identify at least some of the sponsored digital images from a location remote from and over a communication channel to a central receiving agency which stores such images and locator information in memory and provides such locator information to the sponsor..."

Claim 1(c), identifying step, refers to "...the **location** of one or more recipients..." This location appears to correspond to the location of claims 3 and 4 and will be so interpreted.

Claim 1(c) refers to "...corresponding image location information and **the** location of one or more recipients..." However, location of one or more recipients lacks antecedent basis, since location thus far refers to "...1(a) consumer electronically transmitting...from a location remote from..." and "...1(b)...sponsor electronically transmitting...from a location remote from..." These "...remote location(s)..." appear to refer to client devices on a network.

Claim 1(e) reads

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transmitting the corresponding merged digital file for the identified particular stored image in the memory and display such image and the merged information to the printing location of the consumer or identified recipients

In view of the disclosures, Claim 1(e) appears to require

“...transmitting [...merged file .] to the printing location of the consumer or identified recipient...” and

“...displaying [...image and information...] **at** the printing location of the consumer or identified recipient...”

Claim 1(e) refers to “...display such [particular stored image] image and **the merged information**...” However, claim 1(c) has merged only “...consumer identified digital image and corresponding sponsor digital images...” and **not** any other “...information...” into a merged digital [image] file.

Claim 2 refers to a transmitting step and an identifying step in claim 1. In claim 1(a) a customer transmits, and in claim 1(c) the customer identifies. The term “...simultaneously...” is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For purposes of this examination, the term will be interpreted to mean actions that may take place in a single browser session.

Claim 6 refers to “...permit particularizing of information included in the package sent to one or more recipients...” The word *information* appears to be used in claim 6 as a generic term. The term “particularizing” will be interpreted to read on *customizing*.

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Claims 1(f), 6-9 refer to a package. A package is a small or moderately sized pack, i.e, a parcel.¹ This is properly depicted as an envelope shown in Fig. 1, item 127, a flat container (as for a letter).² Figs. 10-11 refers to schematics of a first and second half of the "package." However, the figures show a postcard. A postcard is a card on which a message may be written for mailing without an envelope and to which a sender must affix a stamp.³ The postcard shown in Figs. 10 and 11 is two-dimensional and cannot contain additional items such as a CD required to hold audio files. For purposes of this examination, the term package in claims 1(f), 6-9 will be interpreted to read on a container, that is, a receptacle for holding goods.⁴ Claim 1 will be interpreted to include a step after 1(f) of placing the printed image(s) into a container. Claims 7 and 8 will be interpreted to include precursor steps of transferring digital information to media such as a CD, suitable for physical mailing. In claim 7, the digital data is in the form of audio files. For claim 8, the digital data is in the form of video files. Without these steps, applicant's invention is not operable.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

¹ Definition of *package*, MERRIAM WEBSTER'S Collegiate Dictionary.

² Definition of *envelope*, MERRIAM WEBSTER'S Collegiate Dictionary.

³ Definition of *postcard*, MERRIAM WEBSTER'S Collegiate Dictionary.

⁴ Definition of *container*, MERRIAM WEBSTER'S Collegiate Dictionary.

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be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockhart et al. (US 6,732,152) in view of Fredlund et al. (US 5,666,215).

Lockhart discloses methods and systems for printing and delivering images from digital image files from one or more recipients.

As in claim 1(a), Lockhart discloses that a consumer may electronically transmit digital images to a server at a centralized location (applicant's central receiving agency); see, for example, references to uploading images and file creation, at least Col. 5, line 40-Col. 7, line 4. A consumer may also upload demographic information that identifies the consumer or recipient; see, for example, at least references to demographics, Col. 15, line 46-64. A consumer may transmit digital images from location(s) remote from a server on the network; see, for example, at least references to customers at client devices sending images to servers over communication channels such as the Internet, Fig. 1 and related text. The receiving agency, at a server, receives and stores digital images and other information in memory. See, for example, at least references to mail service computer 110 and associated storage, including databases. See also at least references to Image collections stored in databases, at least Col. 7, lines 5-20. The central receiving agency provides locator information to locate the images after a customer uploads the images. See, for example, at least Fig. 3 and related text concerning links to various images, such as a customer's images.

As per claim 1(b), Lockhart discloses that advertisers, media collection providers, partners and other parties (applicant's sponsors) may electronically transmit at least one sponsor digital image from a remote location, over a communications channel such as the Internet, to a server at a centralized location (applicant's central receiving agency). See, for example, at least references to image collections, partner web sites, Col. 6, lines 53-64. As above, the central receiving agency provides locator information to locate the images after a sponsor uploads the images. See, for example, at least Fig. 3 and related text concerning links to various images.

Along with various images, including advertising images, sponsors may transmit demographic requirements identifying consumers and recipients. For Advertisers as sponsors, please see at least Col. 15, lines 46-63. Sponsors may specify at least some of their digital images, which based upon a correlation between a sponsor's demographic requirements and demographic information that was provided by a consumer, identify at least some of the sponsor's digital images. See, for example, at least references to geographically-targeted advertisements and advertisements based on consumer demographics at least in Col. 15, lines 23-Col. 16, line 24.

As per claim 1(c), Lockhart discloses that a consumer may identify a particular stored image using the corresponding image locator information and the location of one or more recipients. See, for example, at least Fig. 3 and browse button 306. A browse button permits a consumer to browse and identify a particular image using an image's memory locator. See also at least

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references to recipient location indicators, such as New Home/Address links in Fig. 3.

As per claim 1(d), Lockhart discloses merging into a digital file the consumer identified digital image and the corresponding sponsor digital images. See, for example, at least references to merging consumer images and sponsor images and text, at least Col. 10, lines 56-67.

As per claim 1(e), Lockhart discloses transmitting the corresponding merged digital file for the identified particular stored image in the memory and display such image and the merged information to the printing location of the consumer or identified recipients. See, for example, at least references to reviewing, Col. 11, line 53-Col. 12, line 40. A consumer may preview merged digital files at his printing location, home computer-client site via a web browser, for example. See also at least Fig. 4, item 404, which shows an image that may be previewed at a recipient's location.

As per claim 1(f), Lockhart discloses printing the merged image at the printing location corresponding to consumer-identified recipients. See at least Col. 14, lines 27-63. Lockhart discloses delivering printed merged images to locations corresponding to the recipients; see at least Delivery, Col. 14, lines 63-Col. 15, line 7. See also references to printing and sending a mail item, at least Col. 12, lines 14-41.

As per claim 1(g), Lockhart discloses sponsor(s) making at least partial payment to the central receiving agency for the printing and delivering the merged digital file. See, for example, at least references to advertising potential,

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partial or complete underwriting of postage by sponsors, at least Col. 15, line 65-Col. 16, line 16.

As per claim 1, Lockhart **does not** specifically disclose merging files and including them in a package. Fredlund discloses uploading and merging music or voice files, and delivering them to customers.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Lockhart and Fredlund to disclose merging files and including them in a package. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Lockhart and Fredlund to disclose merging files and including them in a package for the obvious reason that consumers may wish to personalize their packages by including their own voice files, possibly singing "happy birthday" or other message on particular occasions.

As per claim 2, Lockhart discloses that electronically transmitting and the identifying steps are preformed simultaneously. See, for example, at least Fig. 3 and browse button 306. A browse button permits a consumer to browse and identify a particular image using an image's memory locator. See also at least references to recipient location indicators, such as New Home/Address links in Fig. 3.

As per claim 3, Lockhart discloses that the recipient location information includes a distribution list originally resident in a personal computer or in a central server managed by the central receiving agency. See, for example, at least

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references to selecting destination addresses from address books, Fig. 2 and related text. See also Addressing, Col. 10, lines 40-55.

As per claim 4, Lockhart discloses that the recipient location information includes the address of each of the recipients and wherein the printed image is delivered by mail to the address of each of the recipients. For recipient addresses, see at least Addressing, address books, Fig. 2 and related text, and Col. 10, lines 40-55. The printed images are delivered by mail to recipient's addresses, as seen in Delivery, Col. 14, line 64-67. See also Fig. 1 and related text, including description of item 120, surface mail.

As per claim 5, Lockhart discloses that sponsor digital images may include advertising information. See at least references to advertisements, Fig. 3, related text and Col. 15, line 46-Col. 16, line 17.

As per claim 6, Lockhart discloses extracting demographic information from the recipient's address and correlating recipient demographic information to permit particularizing of information included in the package sent to one or more recipients. See, for example, at least references to targeting advertisements to recipients based on demographic information such as geographic location of a recipient's address, at least Col. 15, line 46-Col. 16, line 16.

As per claim 7, Lockhart **does not** specifically disclose that a package may include a digital audio file. Lockhart discloses customizing cards for particular occasions, such as birthdays and anniversaries. **Fredlund** discloses uploading and merging music or voice files. See, for example, at least Fig. 1 and related text. It would have been obvious to one of ordinary skill in the art at the

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time the invention was made to combine Lockhart and Fredlund to disclose merging files and including them in a package. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Lockhart and Fredlund to disclose merging files and including them in a package for the obvious reason that consumers may wish to personalize their packages by including their own voice files, possibly singing "happy birthday" or other message on particular occasions.

As per claim 8, Lockhart discloses that the package includes a digital video. See, for example, at least references to video image capture, Col. 9, line 60-Col. 10, line 2. See also references to user graphic images such as might provided by a digital camera, motion video camera and others, at least Col. 4, line 42-Col. 5, line 9.

As per claim 9, Lockhart discloses that the central receiving agency provides bills or charges to the consumer and the sponsor for the printing and delivery of the package. See, for example, at least references to account balances, postcard purchases, Col. 11, line 53-Col. 12, line 14.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 703-308-3588. The

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fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J2

James Zurita
Patent Examiner
Art Unit 2635
9 August 2004

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER